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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,952	08/07/2003	Norishige Morimoto	JP920020098US1	1220

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EXAMINER	
LOVING, JARIC E	

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/635,952	MORIMOTO ET AL.	
	Examiner	Art Unit	
	Jaric Loving	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of §101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Muratani, US 6,901,515.

In claim 1, Muratani discloses a contents server distributing digital contents via a network in response to an acquisition request from outside, said contents server comprising:

a contents storage part for storing a plurality of digital contents wherein a different digital watermark is embedded (col. 1, lines 19-24; col. 14, lines 40-46; col. 28, line 61 – col. 29, line 4); and

an information adding part for, by reading out a plurality of said digital contents from said contents storage part, switching and synthesizing said digital contents for each specific part, adding to said digital contents information specified by a digital watermark being embedded for each part of said digital contents (col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5).

In claim 2, Muratani discloses the contents server according to claim 1, wherein said information adding part dynamically adds said information to said digital contents in response to an acquisition request for predetermined digital contents (col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5; col. 23, lines 18-46).

In claim 3, Muratani discloses the contents server according to claim 1, wherein said information adding part forms a bit row with a digital watermark-embedded for each part of said digital contents and describes said information in said digital contents with said bit row (col. 5, lines 11-60).

In claim 4, Muratani discloses the contents server according to claim 1, wherein said contents storage part stores said digital contents compressed in a predetermined compression format, and said information adding part for, by synthesizing a plurality of

said digital contents based on the codeword sequence offset information regarding said digital contents in accordance with said compression format, adding said information without unpacking said digital contents (col. 12, lines 21-23; col. 36, lines 17-41; col. 37, lines 1-10).

In claim 5, Muratani discloses a contents receiving apparatus for receiving digital contents distributed by a predetermined distributor, said contents receiving apparatus comprising:

a receiving means for receiving a plurality of digital contents wherein a different digital watermark is embedded (col. 1, lines 19-24; col. 14, lines 40-46; col. 28, line 61 – col. 29, line 4); and

an information adding means for, by switching and synthesizing a plurality of said digital contents received by said receiving means for each specific part, adding to said digital contents information specified by a digital watermark being embedded for each part of said digital contents (col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5).

In claim 6, Muratani discloses the contents receiving apparatus according to claim 5, wherein said information adding means adds to said digital contents the information designating the self apparatus and the information regarding the time when said digital contents are distributed (col. 14, lines 40-46; col. 3, lines 20-23 and lines 37-41 – correlation value provides information regarding time).

In claim 7, Muratani discloses the contents receiving apparatus according to claim 5, wherein said information adding means forms a bit row with a digital

watermark-embedded for each part of said digital contents and describes said information in said digital contents with said bit row (col. 5, lines 11-60).

In claim 8, Muratani discloses the contents receiving apparatus according to claim 5, wherein said receiving means receives said digital contents compressed in a predetermined compression format, and said information adding means adds said information without unpacking said digital contents by synthesizing a plurality of said digital contents based on the codeword sequence offset information regarding said digital contents in accordance with said compression format (col. 12, lines 21-23; col. 36, lines 17-41; col. 37, lines 1-10).

In claim 9, Muratani discloses a network system comprising a server distributing digital contents via a network, and a client terminal receiving said distributed digital contents wherein:

said client terminal transmits an acquisition request for desired digital contents to said server (col. 14, lines 40-54); and

said server, by switching and synthesizing for each specific part a plurality of digital contents wherein a different watermark is embedded, generates digital contents wherein a predetermined information responding to said acquisition request is embedded and transmits said digital contents to said client terminal (col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5; col. 23, lines 18-46).

In claim 10, Muratani discloses a network system comprising a server distributing digital contents, and a client terminal receiving distributed digital contents wherein:

said server distributes simultaneously a plurality of digital contents wherein a different digital watermark is embedded (col. 1, lines 19-24; col. 14, lines 40-54; col. 28, line 61 – col. 29, line 4);

said client terminal adds, by switching and synthesizing said plurality of received digital contents for each specific part, a predetermined information to said digital contents (col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5; col. 23, lines 18-46).

In claim 11, Muratani discloses a computer comprising:

a selector for inputting a plurality of digital contents wherein a different digital watermark is embedded, and for outputting while switching selectively said plurality of digital contents for each specific part (col. 1, lines 19-24; col. 14, lines 40-46; col. 28, line 61 – col. 29, line 4); and

a control part for controlling said selector based on a predetermined embedment information, said computer generating by a control at said control part, digital contents wherein said embedment information is described with a bit row being formed by said digital watermark-embedded in each of said part of said digital contents (col. 5, lines 11-60; col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5; col. 23, lines 18-46).

In claim 12, Muratani discloses the computer according to claim 11, wherein said selector inputs a plurality of digital contents where a digital watermark representing the bit information 0 is embedded, and a plurality of digital contents where a digital watermark representing the bit information 1 is embedded, and selects digital contents

where a digital watermark corresponding to desired bit information is embedded under a control of said control part (col. 37, lines 42-53).

In claim 13, Muratani discloses the computer according to claim 11, wherein said selector inputs to said selector digital contents where a digital watermark representing the bit information 0 is embedded, digital contents where a digital watermark representing the bit information 1 is embedded, and digital contents where a digital watermark is not embedded, and selects said digital contents under a control of said control part whereby a portion containing no bit information is set in said bit row describing said embedment information (col. 37, lines 42-53).

In claim 14, Muratani discloses the computer according to claim 11, wherein said selector selectively switches said digital contents, based on the pointer information pointing to a delimiter for said part of said digital contents (col. 14, line 67 – col. 15, line 10; col. 15, lines 30-43).

In claim 15, Muratani discloses the computer according to claim 14, wherein said selector inputs said digital contents compressed in a predetermined compression format, and selectively switches said digital content, using the codeword sequence offset information regarding said digital contents in accordance with said compression format as said pointer information (col. 12, lines 21-23; col. 14, line 67 – col. 15, line 10; col. 15, lines 30-43; col. 36, lines 17-41; col. 37, lines 1-10).

In claim 16, Muratani discloses a method for adding information to digital contents by using a computer, said method comprising;

a first step of generating a plurality of digital watermark-embedded contents by embedding a different digital watermark in predetermined digital contents, and of storing generated digital contents to a predetermined storage device (col. 1, lines 19-24; col. 14, lines 40-46; col. 28, line 61 – col. 29, line 4); and

a second step of, by reading out from said storage device a plurality of digital contents where a different digital watermark is embedded and switching and synthesizing said digital contents for each specific part, adding to said digital contents information specified by a digital watermark being embedded in each part of said digital contents (col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5).

In claim 17, Muratani discloses the method for adding information to digital contents according to claim 16, wherein said first step comprises compressing said generated digital contents, creating the pointer information pointing to a delimiter position in the part of said compressed digital contents, and storing it in said storage device, and said second step comprises reading out said pointer information from said storage device, synthesizing said digital contents based on said pointer information, and adding said information without unpacking the digital contents (col. 12, lines 21-23; col. 14, line 67 – col. 15, line 10; col. 15, lines 30-43; col. 36, lines 17-41; col. 37, lines 1-10).

In claim 18, Muratani discloses a program for causing a computer to perform the data processing by controlling a computer, comprising:

a first process for reading out predetermined embedment information from a predetermined storage device (col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5; col. 28, line 61 – col. 29, line 4); and

a second process for acquiring a plurality of digital contents where a different digital watermark is embedded, selectively switching said plurality of digital contents for a specific part, based on said embedment information, and generating the digital contents describing said embedment information, using a bit sequence formed with a digital watermark-embedded in said part of said digital contents (col. 5, lines 11-60; col. 8, lines 57-63; col. 14, lines 40-46; col. 14, line 67 – col. 15, line 5).

In claim 19, Muratani discloses the program according to claim 18, wherein said second process of said program performed by said computer comprises acquiring a plurality of digital contents where a digital watermark representing the bit information 0 is embedded, and a plurality of digital contents where a digital watermark representing the bit information 1 is embedded, and selecting digital contents where a digital watermark corresponding to appropriate bit information describing said embedment information is embedded (col. 37, lines 42-53).

In claim 20, Muratani discloses the program according to claim 18, wherein said second process of said program performed by said computer comprises acquiring digital contents where a digital watermark representing the bit information 0 is embedded, digital contents where a digital watermark representing the bit information 1 is embedded, and digital contents where a digital watermark is not embedded, and generating digital contents describing said embedment information, using said bit

sequence with said digital watermark where a portion containing no bit information is set (col. 37, lines 42-53).

In claim 21, Muratani discloses the program according to claim 18, wherein said second process of said program performed by said computer comprises acquiring said digital contents compressed in a predetermined compression format, and selecting said digital contents, based on the codeword sequence offset information regarding said digital contents in accordance with said compression format (col. 12, lines 21-23; col. 36, lines 17-41; col. 37, lines 1-10).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Werner et al., US 7,130,443; Moskowitz et al., US 7,007,166; Muratani, US 6,768,807; Ratnakar, US 6,522,766; Pelly et al., US 6,954,857; Rhoads, US 6,944,298; Cox et al., US 5,930,369; Pelly et al., US 7,085,396; Foote et al., US 6,999,598; Iwamura, US 6,807,285; Moskowitz et al., US 5,905,800; Rhoads, US 6,654,887; Yamashita et al., US 2006/0020806; Iwamura, US 2005/0033965; Tachibana et al., US 2002/0006203.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaric Loving whose telephone number is (571) 272-1686. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

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